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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/532,931

04/28/2005

Gerhard Hamprecht

3165-121

3101

6449

7590

03/20/2009

ROTHWELL, FIGG, ERNST & MANBECK, P.C.

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WASHINGTON, DC 20005

EXAMINER

SACKEY, EBENEZER O

ART UNIT

PAPER NUMBER

1624

NOTIFICATION DATE

DELIVERY MODE

03/20/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

Office Action Summary	Application No. 10/532,931	Applicant(s) HAMPRECHT ET AL.	
	Examiner EBENEZER SACKEY	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18,20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/28/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

Claims 1-21 are pending.

This is in response to the office action mailed on 10/29/08.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Information Disclosure Statement

Receipt of the Information Disclosure Statement filed on 04/28/05 is acknowledged and has been entered into the file. A signed copy of the 1449 is attached herewith.

Response to Restriction

Applicant's election with traverse of Group IV, claims 18 and 20-21 in the reply filed on 11/19/2008 is acknowledged. The traversal is on the ground(s) that applicants argue that the elected invention shares a common core structure with the compounds of formula (I) and thus it should be examined together. This is not found persuasive because the compounds of formula (II), the elected invention is broader in scope than the compound which appears in Group I. Additionally, the preparation of formula (II) involves reactants, catalyst and steps not required of Group I.

Thus, claims 1-17 and 19 are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to non-elected subject matter.

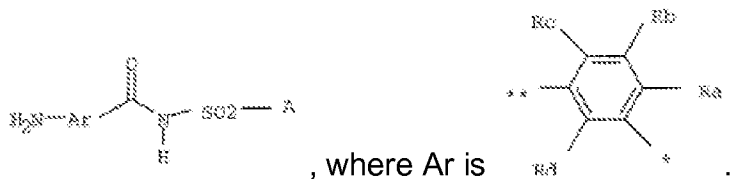
The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

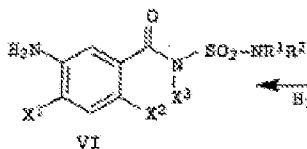
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Carlsen et al., WO 01/83459 A2.

Applicants claim compounds of formula (II), where the variables are as defined:



Carlsen et al., anticipate the instant compounds when X^2 is cyano or hydrogen, X^2 is hydrogen and X^1 is halogen.



. See page 38 of the specification.

Claim Rejections - 35 U.S.C. § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

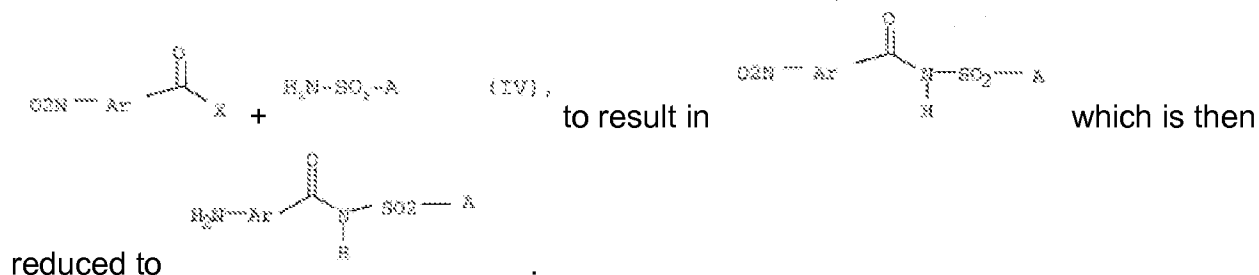
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

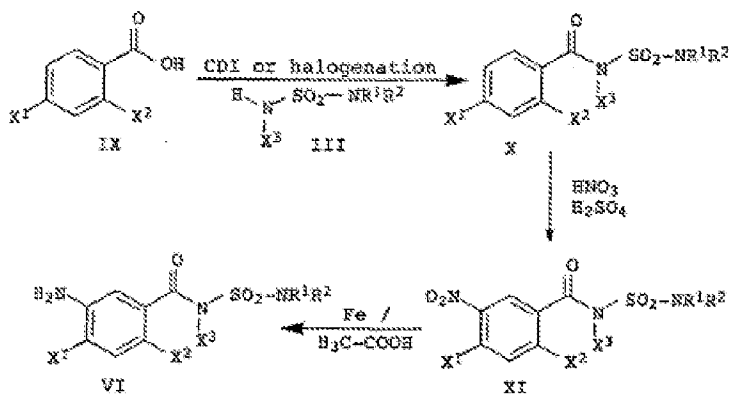
3. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlsen et al., WO 01/83459 A2.

Applicants claim a process for preparing compounds for formula (II), wherein compounds of formula (III) is reacted with sulfamic acid amide of formula (IV), to result in compounds of formula (V), which is then reduced to result in compounds of formula (II):



Determination of the scope and content of the prior art (MPEP §2141.01)

Carlsen et al., teach a process for preparing compounds similar to formula (II). The process of Carlsen is as follows:



Note pages 36 and 38 of the

specification of Carlsen.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The current process differs from Carlsen et al., in the use of analogous reactants.

However, an obviousness analysis requires that the prior art both suggest the claimed subject matter and reveal a reasonable expectation of success to one reasonable skilled in the art. In re Vaeck, 947 F .2d 488, 493, 20 USPQ 2d 1438, 1442 (Fed. Cir. 1991).

Hence, the real difference is the desire to prepare compounds of formula (II). This difference is not expected to change the outcome of the reaction.

Finding of prima facie obviousness---rational and motivation (MPEP §2142-2143)

Thus, at the time of filing this application, one of ordinary skill in the art in possession of Carlsen et al., would have found the instant claim obvious. The requisite motivation being the desire to prepare aminobenzoylsulfamic acid amide of formula (II).

The instantly claimed process would therefore have been suggested to one of ordinary skill in the art absent a showing of unobvious or unexpected results and or properties.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (571) 272-0704. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson, can be reached on (571) 272-0661. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

EOS

**/James O. Wilson/
Supervisory Patent Examiner, Art Unit 1624**